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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,500	02/21/2001	Guillermo Lao	111325-40	6754

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NIXON PEABODY, LLP
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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,500

Applicant(s)

LAO ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-142 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-142 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 09/05/2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because copies of the references cited, which have lines drawn through them were not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Drawings

The drawings filed on 2/21/2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 - 46, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While *Bowman* is not precedential, it has been cited for its analysis.

In claims 99 – 142, the claimed invention is directed to non-statutory subject matter. The claim is directed to an “information storage media comprising information”, which is considered to be non-functional descriptive material per se and is not considered statutory - because the non-functional descriptive material is not capable of causing functional change in the computer. Thereby, the claim does not define any structural interrelationships between the data structure (information) and other claimed aspects of the invention (see MPEP 2106).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 45, 47 – 91, 93, 95, 97 – 141 are rejected under 35 U.S.C. 102(e) as being unpatentable over Spagna (US 6,587,837 B1).

Regarding claim 1 and related claims 47, 93 and 99, Spagna teaches a method for publishing content, the method comprising: receiving a selection of content from a user (see at least Abstract, Col 1, lines 53 – 58 and Col 13, lines 1 – 65); receiving a request to publish the selected content from the user (see at least Col 13, lines 1 – 65); and supplying metadata and a rights specification to a distributor in response to the request from the user to publish the content (see at least Col 9, lines 52 – 67, Col 10, lines 1- 6 and Col 12, lines 24 – 56 as well as Figures 6 and 10).

Regarding claim 2 and related claims 49 and 100, Spagna teaches a method, wherein the metadata includes data describing and identifying the content (Col 12, lines 41 – 43) and (3 and related claims 50 and 101), wherein the metadata includes at least one of a

content identifier, a title, an author's name, a publisher's name, a publication date, an image and a description of the content (Col 60, lines 60 – 67).

Regarding claim 4 and related claims 51 and 102, Spagna teaches a method, wherein the content identifier is at least one of an International Standard Book Number (ISBN), a Digital Object Identifier (DOI), a Uniform Resource Identifier (URI), and a Library of Congress Control Number (LCCN)[Col 20, lines 7 – 8].

Regarding claim 5 and related claims 57 and 103, Spagna teaches a method, wherein the rights specification includes at least one of the rights to print, view, play, extract, and export (Col 12, lines 53 – 56 and Col 21, line 30).

Regarding claim 6 and related claim 104, Spagna teaches a method, further comprising generating the metadata (Col 4, lines 1 – 3 and Col 12, lines 41 – 56 and Figure 12).

Regarding claim 7 and related claim 105, Spagna teaches a method, wherein the step of generating the metadata comprises receiving information from the user (Col 12, lines 52 – 56).

Regarding claim 8 and related claims 56 and 106, Claim 9 and related claims 52 and 107, Claim 10 and related claims 53 and 108 and Claim 11 and related claims 54 and 109, the recitations, " wherein the step of generating the metadata is based upon a user

profile”, “wherein the step of generating the metadata is based upon default metadata”, “wherein the step of generating the metadata is based upon at least one inference rule” and “wherein the step of generating the metadata is based upon an analysis of the selected content”, such recitations are given little patentable weight because they impart no structural or functional specificity which serves to patentably distinguish the instant invention from the other “generating” already disclosed by Spagna.

Regarding claim 12 and related claims 58 and 110, Spagna teaches a method, further comprising creating the rights specification (Col 1, lines 54 – 56, Col 8, line 14 and Col 10, lines 15 – 24).

Regarding claim 13 and related claims 65 and 111, Spagna teaches a method, wherein the rights specification is created based upon a rights template (Col 22, lines 49 – 59).

Regarding claim 14 and related claims 64 and 112, Spagna teaches a method, wherein the rights template includes at least one usage right and a condition upon which the usage right is contingent (Col 3, lines 63 – 67 and Col 4, lines 26 – 30).

Regarding Claim 15 related claims 60, 67 and 113, Claim 16 and related claims 59 and 114, Claim 17 and related claims 61 and 115 and Claim 18 and related claims 62 and 116 the recitations, “wherein the rights specification is created based upon a user profile”, “wherein the rights specification is created based upon a default rights

specification”, “wherein the rights specification is created based upon inference rules”, and “wherein the step of creating the rights specification is based upon an analysis of the selected content”, such recitations are given little patentable weight because these phrases impart no structural or functional specificity which serves to patentably distinguish the instant invention from the other “creating” already disclosed by Spagna.

Regarding claim 19 and related claims 117 and 120, Spagna teaches a method, further comprising creating a publishing profile (Col 9, lines 52 – 57, Col 12, lines 23 – 67, Col 13, lines 1 – 67 and Col 14, lines 1 – 34).

Regarding claim 20 and related claims 69 and 118, Spagna teaches a method, wherein the publishing profile includes at least one publisher identifier and information relating to a pre-existing agreement between at least one of a publisher, a distributor and a registrar (Col 12, lines 53 – 56 and Figures 9 and 10).

Regarding claim 21 and related 70 and 119, Claim 22 and related claims 71 and 121, Claim 23 and related claims 72, 73, 74 and 122, Claim 24 and related claims 75 and 123, and Claim 25 and related claim 76, the recitations “wherein the publishing profile includes information regarding at least one of a distributor and facilitator through which a certain type of content may be at least one of distributed, archived and registered”, “wherein the publishing profile is created based upon a user profile”, “wherein the publishing profile is created based upon a default publishing profile”, “wherein the

publishing profile is created based upon at least one inference rule” and “wherein the publishing profile is created based upon an analysis of the selected content”, such recitations are given little patentable weight because these phrases impart no structural or functional specificity which serves to patentably distinguish the instant invention from the other “information including and creating” already disclosed by Spagna.

Regarding claim 26 and related claim 125, Spagna teaches a method, further comprising confirming the request to publish (Col 14, lines 1 – 15).

Regarding claim 27, Spagna teaches a method, wherein the user is a publisher (Col 15, lines 16 – 19).

Regarding claim 28 and related claim 126, Spagna teaches a method, wherein the step of supplying comprises sending a publication notice to at least one distributor (Col 21, lines 16 – 18).

Regarding claim 29 and related claim 127, the recitation, “wherein the step of supplying further comprises receiving a response from the at least one distributor”, such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “supplying” already disclosed by Spagna.

Regarding claim 30 and related claim 128, Spagna teaches a method, further comprising packaging the content for the distributor if the response from the at least one distributor indicates that the distributor wants to distribute the content (Col 21, lines 19 – 24).

Regarding claim 31, Spagna teaches a method, wherein the user is the distributor (Col 15, lines 16 – 19).

Regarding claim 32, Spagna teaches a method, wherein the user is a content creator (Col 15, lines 16 – 19).

Regarding claim 33 and related claims 86 and 129, Spagna teaches a method, further comprising packaging the content (Col 21, lines 1 – 6).

Regarding claim 34 and related claims 87 and 130, Spagna teaches a method, wherein the step of packaging comprises sending the content to a distributor (Col 21, lines 19 – 21).

Regarding claim 35 and related claim 131 as well as Claims 41, 48, 55, 63, 66, 68, 77, 79, 80, 82, 95, 98, and 137, Spagna teaches a method and system including “storing” (see at least Col 12, lines 46 – 48 and Figure 9 and Figure 12). Please note for these claims that in online methods and systems for publishing content that include the word

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“storing” adding such specifics as “at least one user profile” is given little patentable weight. The phrase(s) and or word(s) after ‘storing’ are given little patentable weight because the claim language limitations are considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from Spagna. Thereby, the non-fictional descriptive material is directed only to the content of the stored data and does not affect either the structure or method/process of Spagna, which leaves the method and system unchanged.

Regarding claim 36 and related 88 and 132, Spagna teaches a method, wherein the step of packaging comprises encrypting the content (Col 21, lines 1 – 3).

Regarding claim 37 and related claims 81 and 136, Spagna teaches a method, wherein the step of packaging comprises sending the content to a content repository (Col 21, lines 7 – 8).

Regarding claim 38 and related claims 89 and 134, Spagna teaches a method, further comprising registering the content (Col 45, lines 38 – 65).

Regarding claim 39 and related claims 90 and 135, Spagna teaches a method, wherein the step of registering comprises forwarding at least one of metadata, a record of published content, a content identifier, the rights specification and marketing information to a registrar (Col 45, lines 38 – 65).

Regarding claim 40, Spagna teaches a method, further comprising registering the transaction of supplying (Col 45, lines 66 – 67 and Col 46, lines 1 – 5).

Regarding claim 42 and related claims 84, 85 and 138, Spagna teaches a method, wherein the step of supplying comprises: preparing a notice that includes the metadata and rights specification; and sending the notice to the distributor (Col 71, lines 31 – 34).

Regarding claim 43 and related claim 139, Spagna teaches a method, further comprising using at least one distributor business rule to determine whether the distributor wants to distribute the selected content and wherein the supplying is based upon the determination (Col 45, lines 32 – 42).

Regarding claim 44 and related claim 140, Spagna teaches a method, further comprising receiving a response from the distributor and wherein the supplying is based upon the response (Col 45, lines 32 – 42).

Regarding 45 and related claim 141, Spagna teaches a method, further comprising updating a distributor catalog based upon the metadata and rights specification (Col 46, lines 1 – 3).

Regarding claim 78, Spagna teaches a system, wherein the processor is further responsive to user input to create the content (Col 12, lines 34 – 36).

Regarding claim 83, Spagna teaches, wherein the processor is further responsive to request to supply a confirmation request and to receive a confirmation before supplying the metadata and rights specification (Col 22, lines 61 – 65 and Col 26, lines 10 – 19).

Regarding claim 91, Spagna teaches a system, further comprising: a distributor system in selective communication with the publishing system, wherein the distributor system comprises: a catalog database for storing metadata and rights specifications associated with at least one content; an interface for selective communication with a publishing system; and a distributor processor in communication with the interface and the catalog database, wherein the processor is responsive to the supplied metadata and rights specification to determine whether to store the supplied metadata and rights specification in the catalog database (see at least Col 9, lines 52 – 56, Col 73, lines 47 – 56 and Figure 15B).

Regarding claim 97, Spagna teaches a system, further comprising: a consumer interface in communication with the processor; and a consumer database in communication with the processor, wherein the consumer database stores at least one consumer profile (Col 9, lines 57 – 60).

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Regarding claim 124, Spagna teaches a media, further comprising: information that analyzes the selected content; and information that creates a publishing profile based upon the results of the analysis (Col 55, lines 46 – 50).

Regarding claim 133, Spagna teaches, wherein the information that packages the consent comprises information that sends the content to a consent repository (Figure 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46, 92, 94, 96 and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna (US 6,587,837 B1) in view of Ginter (US 6,253,193 B1).

Spagna discloses and teaches substantially the applicant's invention.

However, Spagna does not specifically disclose and teach a method, further comprising modifying one of the metadata and rights specifications based upon a distributor business rule.

On the other hand and regarding claim 46 and related claims 92, 94, 96 and 142, Ginter teaches a method, further comprising modifying one of the metadata and rights specification based upon a distributor business rule (see at least Col 2, lines 46 – 53).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Spagna with the method and system of Ginter to have enabled a method, further comprising modifying one of the metadata and rights specification based upon a distributor business rule – in order to modify a metadata and associated rights to meet the needs of individual users. In this manner, the flexibility of the method and system will be enhanced, which will increase customer satisfaction and thereby increase the potential number of total users who would be willing to use as well as pay.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

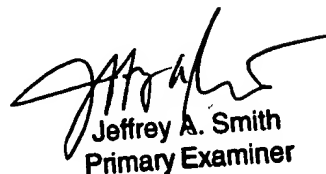
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

RER


Jeffrey A. Smith
Primary Examiner